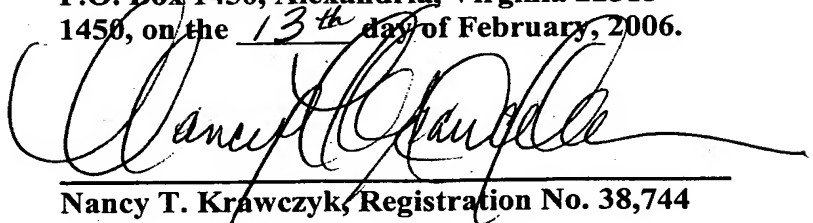




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APPELLANT'S BRIEF AND APPENDICES

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Nancy T. Krawczyk, Registration No. 38,744

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)

John Eric Arnold)

For: PART NUMBER IDENTIFICATION)

TAG)

Serial No. 10/069,301

Filed: February 18, 2002

Confirmation No.: 2013

Docket No.: DN1999215USA

Art Unit: 3683

Examiner: Melanie Torres

**BEFORE THE BOARD OF
PATENT APPEALS AND
INTERFERENCE**

Mail Stop Appeal Brief-Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, Virginia 22313-1450

APPELLANT'S BRIEF

Dear Sir:

Appellant, by virtue of his Notice of Appeal filed February 16, 2005, hereby files his corrected Brief in response to the Final Rejection of all pending claims in the above-identified application and in response to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37), mailed January 27, 2006. Authorization to charge Appellant's Deposit Account No. 07-1725 in the amount of Five Hundred and 00/100 Dollars (\$500.00) to cover the fee for filing the Appeal Brief was authorized in Appellant's Appeal Brief filed on 19 April 2005.

Real Party in Interest

The real party in interest of the present application is The Goodyear Tire & Rubber Company.

Related Appeals and Interferences

There are no related appeals or interferences.

Status of Claims

Claims 1-10 are pending in the application. Claims 1-10 stand rejected and are appealed.

Status of Amendments

There are no outstanding amendments. No amendments have been filed subsequent to the last Office Action mailed on November 16, 2004.

Summary of the Claimed Subject Matter

The claimed subject matter is an airspring. The airspring 10 has a reinforced elastomeric sleeve 16. To form an airtight assembly comprising an internal chamber, the sleeve 16 is secured at both ends, with a retainer 14 securing a first end of the sleeve (pg 2, lines 15-25). For identification of the airspring product, secured between the retainer 14 and the sleeve 16 is an identification tag 12 (Fig. 1; pg 2, lines 25-26). The tag 12 is secured to the airspring components at the same time as the retainer 14 is crimped onto the end of the sleeve 16 (pg 2, lines 27-34).

The tag 12 is formed from a single sheet-like material (Figs. 1 and 3). When secured to the airspring, the tag 12 has an upper end 34 having an s-shaped configuration corresponding to the crimped upper end of the sleeve 16 (Fig. 2; pg 3, lines 1-2) and an extending end 30 wherein the identifying indicia is provided. The extending end 30 may also have a configuration corresponding to the curvature of the airsleeve 16 (Fig. 2; pg 3, lines 2-5). The different curved portions of the tag may be formed prior to securing the tag 12 to the airspring sleeve 16 or occur due to the use of a flexible material forming the tag 12.

The principal aspect of the claimed invention is that the tag 12 is secured to in the airspring 10 in a non-removable manner (pg 1, lines 34-35). By crimping the retainer about the sleeve end and the tag, the tag 12 cannot be removed from the airspring 10 but becomes a permanent part of the airspring 10. This tag 12 replaces previously known and conventional airspring identification methods such as adhesive labels that may become unglued or otherwise damages and printing directly on the airsleeve which may become scrapped off or worn away.

Ground of Rejection to be Reviewed on Appeal

Whether the claims are obvious under 35 U.S.C. § 103(a) over Geno et al. in view of Robinson.

Arguments

Rejection under 35 U.S.C. § 103(a) as obvious over Geno et al in view of Robinson.

The claims stand rejected under 35 U.S.C. § 103(a) as obvious over Geno et al in view of

Robinson. 35 U.S.C. § 103(a) recites:

A patent may not be obtained though the invention is identically disclosed or described as set forth in section 10 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the was made to a person having ordinary skill in the art to which said subject matter pertains.

Geno et al is cited as teaching an air spring comprising a flexible cylindrical sleeve having a first and second end and a retainer secured to one of the ends of the sleeve. It is recognized that Geno et al does not teach a tag made of sheet material that is non-removable secured between the sleeve and the retainer. In fact, Geno et al provides no form of identification tagging for the air spring.

Robinson is cited as teaching a tag made from a sheet material with a portion of the tag being "non-removably secured between a sleeve (1) and a retainer (5)." Robinson, in fact, discloses a method of providing tags for can-like containers; Robinson being specifically concerned about paint cans with the tag providing information regarding the contents of the can (pg 1, lines 3-5). The tag is provided with a tongue or projection that is passed through a hole formed in the lid of the can-like container (pg 1, lines 13-18).

It has been held that it would have been obvious to one skilled in the art to use the tag of Robinson on the air spring of Geno to provide identification for the manufactured part. Appellant disagree.

To establish *prima facie* obviousness, there 1) must be some suggestion or motivation in the art to modify or combine the references; 2) must be a reasonable expectation of success and 3) the combined references must teach or suggest all the claim limitations.

First, there is no motivation in the art to modify Geno et al or combine the teachings of Robinson with Geno et al. It is stated in the rejection of the claims that the reason to provide a tag would be to provide identification for the manufactured part. However, this argued motivation is not set forth in either reference. Geno is silent about the need to provide any external identification tag. Robinson teaches that the tag is to provide information about the contents of the can; for an air spring there is no such need – those skill in the art know what is inside an air spring – air or another inert gas. The only motivation to provide Geno et al with a part identification tag is provided with Appellant's specification. To combine these references in the manner set forth in the rejection is solely based upon hindsight provided by Appellant's

own teachings. There is no motivation to combine these references other than to make the present rejection.

In response to this argument, in the Final Office Action of 11/16/2004, it is stated that motivation to combine or modify references may be found either in the references themselves "or in the knowledge generally available to one of ordinary skill in the art," relying upon *in re Fine* and *in re Jones*. The Examiner never states it, but appears to be relying upon "knowledge generally available to one of ordinary skill in the art" for motivation to combine.

However, in *in re Fine*, the failure of the references to provide such motivation led the court to a holding of hindsight in the formulation of the rejection, and a holding by the court that a *prima facie* case of obviousness had not been established.

Additionally, the court's position in *in re Jones* is not fully set forth in the above-cited proposition. The court stated "It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references", *id*, 5 USPQ2d at 1598 (emphasis added). Thus the court supported the position that motivation must still come from the prior art. In fact, the court cited *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 USPQ 929, 933 (Fed Cir 1984), that obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination:" and "teachings of references can be combined *only* if there is some motivation or incentive to do so."

In *in re Jones*, the court looked for evidence, other than speculation, in the prior art for the rejection. That court stated "there must be adequate support in the prior art ..., in order to complete the PTO's *prima facie* case and shift the burden of going forward to the applicant", *id*, 21 USPQ2d at 1944 (citing *in re Lahu*, 223 USPQ 1257, 1258 (Fed Cir 1984)).

Motivation in the prior art is an essential requirement of the law to establish *prima facie* obviousness, not mere speculation. Again, as noted above, there is no motivation in *Geno et al* to look to apply an identification tag to the air spring during manufacture of the air spring. *Robinson* teaches applying a tag for the purpose of identifying the contents of the can. The sole motivation to use a tag of the type of *Robinson* in the air spring of *Geno et al* is provided by hindsight. The PTO has failed to meet their burden of *prima facie* obviousness.

Second, to modify the air spring of *Geno et al* in the manner as taught by *Robinson*, the retainer of *Geno et al* must be provided with a hole through which the tag must pass. Because the goal of an air spring is to have control over the airflow into and out of the air spring, to

simply punch a hole into the retainer would potentially destroy the operability of the air spring. One of ordinary skill in the air spring art would not seek to place additional holes in the retainer, potentially destroying the sealed chamber. Additionally, Robinson teaches the use of an additional lip 4 over the can-like container that cooperates with the lid and the tag. The addition of a similar lip is not practical for the sleeve of an airspring, as the lip of Robinson requires the material of both the lip and the container to be a non-flexible material, while the sleeve of an airspring must be a flexible element to permit the airspring to operate.

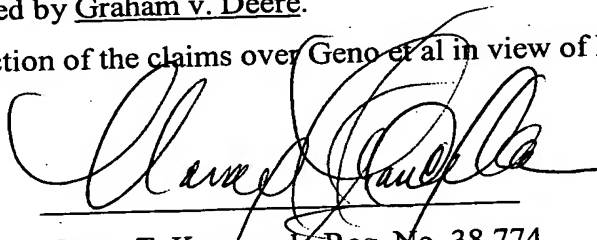
In response to this argument, in the Office Action of 11/16/2004, it is held that such arguments make presumptions about the teachings of Robinson, and there is no gap between the components. No such assertion is being made by Appellant. Appellant is stating that one skilled in the art would not seek to provide additional holes in a product meant to be airtight nor would they seek to use a lip 4 like that required by Robinson to effect sealing and mounting of the tag.

It is also stated that this argument is deemed more specific than the claim language. Presumably, this means that the argument that the airspring must be sealed to form an airtight seal between the retainer and the sleeve is more specific than the claim language. Appellant disagrees. By mere recitation of the product as being an air spring, one skilled in the art is aware that an air tight seal must be achieved and maintained between the retainers and the sleeve in order to obtain the internal air chamber; air travels into and out of an air spring only through the designated air passage located in the retainer (see FIG. 1). To call this argument "more specific than the claim language" is akin to requiring a tire claim to recite the tire as being round – it is an inherent, understood feature of the product.

Third, the presently claimed invention recites that the tag is non-removably secured to the airspring. Such is not the case with the paint can of Robinson. A paint can lid is often removed, and the tag may be readily removed from the slot in the lid. Thus, an essential element of the recited invention is not disclosed in either Geno et al or Robinson.

Thus, *prima facie* obviousness has not been established as the rejection fails to meet all three of the requirements established by Graham v. Deere.

It is requested that the rejection of the claims over Geno et al in view of Robinson be withdrawn.



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CLAIMS APPENDIX

CLAIMS

1. An airspring comprising a flexible cylindrical sleeve having a first and second end, a retainer secured to one of the ends of the sleeve, and a tag made from a sheet material, the improvement comprising:
a portion of the sheet material forming the tag being non-removably secured between the sleeve and the retainer.
2. An airspring in accordance with claim 1 wherein the tag is of a flexible plastic or elastomeric material.
3. An airspring in accordance with claim 1 wherein the portion of the tag that is secured between the sleeve and the retainer, prior to being secured between the sleeve and the retainer, has a shaped configuration corresponding to the shaped configuration of the sleeve end.
4. An airspring in accordance claim 1 wherein the tag, prior to being secured between the sleeve and the retainer, has a molded circumferential curvature corresponding to the outer curvature of the cylindrical sleeve.
5. An arising in accordance with claim 1 wherein the tag is provided with indicia in a manner which will last the lifetime of the airspring.
6. An airspring in accordance with claim 5 wherein the indicia is presented in an alphanumeric manner or as a bar code.
7. An airspring in accordance with claim 5 wherein the indicia is formed by punching out the idicia from the tag, stamping the indicia onto the tag, or imprinting the indicia onto the tag.
8. An airspring in accordance with claim 1 wherein the color of the tag contrasts with the color of the airsleeve.

9. An airspring comprising a flexible cylindrical sleeve having a first and second end, a retainer secured to one of the ends of the sleeve and a tag made from a sheet material, a portion of the tag being non-removably secured between the sleeve and the retainer, wherein the portion of the tag that is secured, prior to being secured, has a shaped configuration corresponding to the shaped configuration of the sleeve end.
10. An airspring comprising a flexible cylindrical sleeve having a first and second end, a retainer secured to one of the ends of the sleeve and a tag made from a sheet material, a portion of the tag being non-removably secured between the sleeve and the retainer, wherein the tag, prior to being secured, has a molded circumferential curvature corresponding to the outer curvature of the cylindrical sleeve.

EVIDENCE APPENDIX

Evidence

No evidence has been submitted in the present application pursuant to 37 CFR 1.130, 1.131, or 1.132. Nor is there any additional evidence relied upon by Appellant in the appeal.

RELATED PROCEEDINGS

APPENDIX

Related Proceedings

There are no related proceedings or decisions related to the present case.